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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,729	04/27/2005	Shigeyoshi Kouno	P27797	8751
7055	7590	08/20/2008		
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER				
HOWELL, DANIEL W				
ART UNIT		PAPER NUMBER		
3726				
NOTIFICATION DATE		DELIVERY MODE		
08/20/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/532,729

Applicant(s)

KOUNO ET AL.

Examiner

Daniel W. Howell

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3-11-08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The previous examiner has left the PTO. Note the new contact information below.
2. Before making any rejections, the examiner will make several comments. As correctly pointed out in Applicant's comments, the Endo reference is not a tap. However, upon close reading of the claims, one can understand why the previous examiner applied Endo. Claims 3 and 7 set forth the limitation that the tap holder is "provided so as to be movable only in the/a vertical direction." This limitation does not correctly represent Applicants' invention. Referring to figure 1, tap holder 45 is keyed to shank body 37 at 43, such that they will **rotate together**. Shank body 37 is keyed to rotating sleeve 11 at key 39, and of course sleeve 11 is rotated through the worm wheel 13. Applicants' claim prohibits the tap from rotating, so the previous examiner applied art (Endo) having a tool that didn't rotate. Unfortunately, the previous examiner didn't make a 112, 2nd P, rejection to let Applicants know that claims 3 and 7 are wrong. Appropriate rejections will be made on this topic below, but applying art to claims 3 and 7 now, when they misrepresent how the device actually works, is going to be awkward.
3. Claims 3-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 3 and 7 set forth the limitation that the tap holder is "provided so as to be movable only in a vertical direction." This limitation does not correctly represent Applicants' invention. Rotation of worm wheel 13 causes rotation of sleeve 11, which rotates shank body 37 through key 39, which rotates tap holder 45 through key 43. Note also that the only way for the tap to cut the threads is for the tap holder to rotate. Claims 3 and 7 need to be appropriately amended to accurately set forth how the device operates. Both claims 3 and 7 need to set forth appropriate structure by which the tap holder is "urged upwards." For reference sake, this would

be spring 49. Claims 3 and 7 state that the downward movement transmitter receives and transmits motion downward, but it does not clearly state what this motion is transmitted to. Note that claims 3 and 7 state only that the transmitter is movable in the vertical direction to the tap holder. Claim 10 clearly has some missing subject matter, as it abruptly ends, "to lower."

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 4-63622. Note rotating mold indexing device 11 of the punch press. Tap holder 71 with tap 69 is provided in a vertically movable shank body 63, which is attached to the indexing device 11. When ram 33 strikes downward movement transmitter 77 (which is also located in shank body 63), both the shank body and tap holder 71 are moved vertically. Note from figure 6 that a spring (61 or 57a) urges the tap holder upward. Workpiece brace 57 is at the lower end of the shank body, and bearings are located between the brace and tap holder (65), and the brace and the shank body (73).

6. Claims 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 4-71731. Note rotating mold indexing device 13 of the punch press. Tap holder 55 with tap 57 is provided in a vertically movable shank body 53, which is attached to the indexing device 13. When ram 23 strikes downward movement transmitter 59 (which is also located in shank body 53), both the shank body and tap holder 55 are moved vertically. Note from figure 1 that a spring 45 urges the tap holder upward. Workpiece brace 43 is at the lower end of the shank body, and bearings are

located between the brace and tap holder, and the brace and the shank body. Figure 3 shows an oil supply 87C which extends from the transmitter to the tap holder.

7. The examiner will delay commenting on allowable subject matter for the remaining claims until seeing how the claims are amended.

8. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, David Bryant, may be reached at 571-272-4526.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3726 at the top of your cover sheet.

/Daniel W. Howell/
Primary Examiner, Art Unit 3726